



UNITED STATES PATENT AND TRADEMARK OFFICE

mn
UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/706,568

11/12/2003

Yoshitaka Nakayama

17210

6919

23389 7590 06/20/2007
SCULLY SCOTT MURPHY & PRESSER, PC
400 GARDEN CITY PLAZA
SUITE 300
GARDEN CITY, NY 11530

EXAMINER

MORAN, RANDAL D

ART UNIT

PAPER NUMBER

2135

MAIL DATE

DELIVERY MODE

06/20/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/706,568	Applicant(s) NAKAYAMA, YOSHITAKA	
	Examiner Randal D. Moran	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Chandrayan B. Th
AUC 2135

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>See Continuation Sheet</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :11/12/2003, 5/13/2004, and 8/15/2005.

DETAILED ACTION

1. The examiner has considered the Information Disclosure Statements filed on 11/12/2003, 5/13/2004.
2. Claims 1-12 are pending in the application.
3. Below, Examiner has pointed out particular references contained in the prior art(s) of record in the body of this action for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures may apply as well. Applicant should consider the entire prior art as applicable as to the limitations of the claims. It is respectfully requested from the applicant, in preparing the response, to consider fully each reference in its entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior arts or disclosed by the examiner.

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. **Claims 1-12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter, as it does not fall under any of the 4 statutory classes of inventions.

- Considering **Claims 1, 2, 5, and 10**, the language in the claims raise an issue because a "token table" does not define a physical structure and is directed merely to an abstract idea that is not tied to an article of manufacture which would result in a practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101. The claims could reasonably be drawn to functional descriptive material, per se, i.e., "program" may be taken to mean software alone, and as such, the claims would be directed to non-statutory subject matter.
- Considering **Claims 3 and 11**, the language in the specification (p. 18- lines 11-12) raise an issue because the "recording medium" is defined to include "other recording media" which could be interpreted to mean electric signals or carrier waves. Thus, the claims would be directed merely to an abstract idea that is not tied to an article of manufacture which would result in a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.
- Considering **Claims 4 and 12**, the claims are clearly not a "process" under § 101 because it is not a series of steps. A claimed signal has no physical

Art Unit: 2135

structure, does not itself perform any useful, concrete and tangible result and, thus, does not fit within the definition of a "machine". A claimed signal is not matter, but a form of energy, and therefore is not a "composition of matter". Manufacture is defined as the production of articles for use from raw or prepared materials by giving to these materials new forms, qualities, properties, or combinations, whether by hand-labor or by machinery. A signal, a form of energy, does not fall within the accepted definition of manufacture. Thus, a signal does not fall within one of the four statutory classes of § 101 and is therefore deemed non-statutory subject matter.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. **Claims 1-12** are rejected under 35 U.S.C. 102(b) as being anticipated by **Touboul (US 6,092,194)**, hereafter "Touboul".

3. Considering **Claims 1-4 and 10-12**, Touboul discloses a permission token management method (column 4- lines 14-28, Fig. 2, Fig. 3) comprising the steps of: storing tokens which correspond respectively to a plurality of permissions installed in a terminal (column 4- lines 14-40, Fig. 3) and are calculated by a predetermined conversion process performed to permission character strings indicating the permissions (column 4- lines 45-47, digital hash of the downloadable code); when a permission character string indicating a specific permission is input (column 4- lines 41-45), performing the predetermined conversion process to the permission character string (column 4- lines 41-45); and searching a token table using a token which is a conversion result of the conversion process (column 5- lines 24-29), and determining whether the token exists in the token table or not (column 5- lines 24-29, column 6- lines 4-12).

4. Considering **Claims 5 and 10-12**, Touboul discloses a permission token management method (column 4- lines 14-28, Fig. 2, Fig. 3) comprising the steps of: storing tokens which correspond respectively to a plurality of permissions installed in a terminal (column 4- lines 14-40, Fig. 3) and are calculated by performing a predetermined conversion process to permission character strings indicating the permissions (column 4- lines 45-47, digital hash of the downloadable code); when a permission character string indicating a permission necessary for normally operating an application program intended to be downloaded is input (column 4- lines 41-45, column 6- lines 4-12), outputting a

search request including the permission character string (column 4- lines 62-67, column 5- lines 1-16); performing the predetermined conversion process to the permission character string included in the search request (column 4- lines 45-47), and outputting a token which is a conversion result (column 4- lines 41-61); and by using the token (column 5- lines 4-16), determining whether a permission necessary for normally operating the application program is installed in the terminal or not (column 5- lines 24-29).

5. Considering **Claim 6**, Touboul discloses a token attribute information table (column 4- lines 14-28, Fig. 2, Fig. 3) within which, relating to each of the plurality of permissions installed in the terminal, a token of the permission and attribute information including conditions of use are registered in correspondence with each other (column 4- lines 14-28); a permission database (column 4- lines 21-28); token obtaining means for, when a permission character string indicating a permission desired for use is output from the application program at the time of executing the application program (column 4- lines 41-61), outputting a token obtaining request including the permission character string to the conversion means (column 4- lines 41-61), and receiving a token output from the conversion means responding to the token obtaining request (column 5- lines 4-15); and second searching means for determining whether to authorize the application program to use the permission or not (column 6- lines 13-24), in accordance with the attribute information of the permission which corresponds to the token and is

Art Unit: 2135

obtained by searching the permission database using the token received by the token obtaining means (column 4- lines 62-67, column 5- lines 1-15); wherein the conversion means has a function of, responding to the token obtaining request from the token obtaining means, performing the predetermined conversion process to the permission character string being requested for obtaining the token (column 4- lines 45-46), and outputting a conversion result to the token obtaining means (column 5- lines 4-15), and the search request/saving means has a function of, when the permission necessary for normally operating the application program is determined by the first searching means to be installed in the terminal (column 5- lines 24-29), obtaining the attribute information of the permission from the token attribute information table column 5- lines 36-38), and registering in the permission database the attribute information and the token of the permission in correspondence with each other (column 4- lines 14-28 and 57-61).

6. Considering **Claim 7**, Touboul discloses the conditions of use of the permission include an identifier of the application program (column 4- lines 41-45).
7. Considering **Claim 8**, Touboul discloses the conversion means has a function of obtaining a hash value corresponding to a permission character string (column 4- lines 45-47).

8. Considering **Claim 9**, Touboul discloses the token has less number of characters than that of the permission character string (column 4- lines 45-47, column 9- lines 43-56, Fig. 8).

Conclusion

1. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 2005/0055155 – Navigation System Utilizing Token Management.
- US 2006/0059548 – Token State Monitoring.
- US 2006/0015932 – Security Token Management Architecture.
- US 2006/0010489 – Enhanced Wireless Security.
- US 2004/0123152 – Framework for Security Tokens.
- US 2004/0093502 – Authentication Using Token Exchange.
- US 6,161,182 – Token Generation Server.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Randal D. Moran whose telephone number is 571-270-1255. The examiner can normally be reached on M-F: 7:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2135

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randal D. Moran
/RDM/

6/8/07

Chandraya B. Thy
AU2135